IN THE SUPREME COURT OF THE UNITED STATES

BENJAMIN ARTHUR BOURNE,

Petitioner,

versus

LUTHER JONES

Respondent.

BRIEF ON BEHALF OF RESPONDENT

The transcript of record will be referred to thus: (R.). Reference to Petitioner's brief will be referred to thus: (Br.). Unless otherwise indicated all emphasis is supplied by the brief writer.

STATEMENT OF THE CASE

So much of the Petitioner's statement of the case as sets forth the filing of the complaint and amendment thereto, the filing of defense on merits, the filing of defense specifications, trial of the case, the entry of a final decree for Respondent, the filing of a motion for rehearing, amendment and corrections of the findings of fact and conclusions of law, the entry of an order denying the motion, the perfection of an appeal to the Court of Appeals for the Fifth Circuit and entry of an order affirming the District Court and denying a rehearing are correct. However, the rest of the statement of the case which purports to set forth evidence (R. 4-5) is but the one-sided interpretation by Petitioner of isolated portions of the record. It completely ignores the findings of fact of the District Court (R. 21-34) and the voluminous record upon which those findings were based.

The Court of Appeals for the Fifth Circuit affirmed the Lower Court and held the the findings of fact were correct and were based on substantial evidence. This evidence established the following facts:

In the early twenties Louisiana was the only sugar producing area in the United States. A disease later known as "mosaic" was decimating the cane fields. Extinction was threatened. Faced with economic ruin, the industry turned to the United States Department of Agriculture to discover the cause of the disease and the possible remedy. After ten years of intense study, investigation and breeding, successful results were attained (R. DX5 and DX6).

Doctor E. W. Brandes began work on this problem in Puerto Rico in 1915 where he observed the disease spread to Louisiana, and discovered it was a virus disease transmitted by an insect vector (R. Brandes 187-189). His studies lead him to the conclusion that the disease could be controlled by varieties which were disease resistent and which would give an increased sugar yield. This lead to the development of the "tri-species" theory of crosses in breeding new varieties of cane and was the key to the success (R. Brandes 191). The "tri-species" pattern of crossing basically is the crossing of species saccharum officinarum, saccharum spontaneum and saccharum barberi involving the crossing of canes from New Guinea and India (R. DX4). *Dr. Brandes made the first* cross of seedlings producing a new variety in North America at Collins Key, Miami Beach, in the year 1919 (R. Brandes 194). Potentially each seed was a new and distinct variety and blooms were essential to the production of seed.

A year or two later Brandes established the Canal Point Field Station for the Department of Agriculture dedicated solely to long-range breeding program. In 1926 Brandes employed the Petitioner to operate this station. Bourne was then attending Cornell University; he had not yet obtained his Ph.D. Degree. He conducted this station until 1929 under the guidance of Dr. Brandes and Brandes taught him the tri-species method of crossing (R. Brandes 196-197).

Initially, this work was slanted towards new varieties for Louisiana since Florida had no cane industry. In the late twenties, commercial planting by Florida Sugar and Food Produce Company was underway in the vicinity of Canal Point. Before 1927 Southern Sugar Company succeeded Florida Sugar and Food Produce Company and by 1931 it in turn was succeeded by U. S. Sugar Corporation.

The State Experiment Station at Belle Glade became interested in testing new varieties for local use, as well as Canal Point. All interests decided to pool their scientific breeding work and entered into a cooperative agreement (R. DX7). This agreement was succeeded by another effective March 22, 1930 (R. DX8). Though signed by Southern Sugar Company, this agreement is still in full force and effect as U. S. Sugar succeeded to their assets and contracts when it took over the former (R. Bourne 91; R. Stevens 250).

Dr. Brandes imported foreign breeding stock making trips to Formosa, Phillipines, India and Indonesia. Eventually 700 original varieties were collected. Because of the danger of transmittal of disease no foreign cane could be brought in except through the United States Department of Agriculture (R. Brandes 195-196).

In 1929 Petitioner left the Canal Point Station and went to work for Southern Sugar Company, where he set up a breeding program for his employer. Southern Sugar Company went into receivership within a year and Bourne, then being out of a job, was employed as a cane breeder by Everglades Experiment Station

at Belle Glade, Florida, which at that time embarked on a breeding program of its own (R. Allison 224, 227-228; Stevens 250; Brandes 196).

A Dr. Allison, director of Everglades Experiment Station, a few months before Bourne became employed by it, employed F. D. Stevens, an experienced cane man who had worked for the United States Department of Agriculture in Louisiana for a number of years. The breeding program and sugar cane investigation were divided between these two men with Bourne assigned the task of making the crosses and Stevens doing the agronomic studies. Aside from breeding cane, which occupied his time only a few months during the short blooming season, Bourne conducted other cane work such as pathological and morphological studies outlined in his projects (R. Allison 224-228; Bourne 93; R. DX10, 11, 12, 13, 14, 16, 17, 18 and 19).

The mechanical act of making a cross involves merely the shaking of the pollen of a bloom of one sex into the inflourescence or bloom of another sex. A Negro or fiield hand often does this work and no two varieties can be crossed unless they bloom at the same time (R. Bourne 98). A single cross will often produce several thousand seeds. No prediction can be made which seed will produce the most desirable plant, so that all must be planted and after maturity those which show promise must be subjected to the arduous tests requisite in order to evaluate them (R. Bourne 99-107).

The "breeder" in this instance germinates the seed in flats under cover, transplanting good sprouts to pots where they continue to grow in the field house

and then after a certain stage of growth transplanting the same in the field. Upon maturity in the field the breeder discards all the new plants which do not show a hearty, thrifty growth upon visual inspection. Those left are subjected to a field test for total solids and sugar contents. This is done by boring the stalk, squeezing out the segment removed with a pair of pliers and examining the same with a Zeiss hand refractometer, which is done in the field. This test is to determine the potential sugar yield (R. 105-106; R. Stevens 246-248.). Countless plants are then eliminated and the remaining varieties which show promise are turned over to the agronomist for numerous tests to select the variety which are ready for commercial production (R. Stevens 248-249).

The agronomist takes the initial plant, known as a stool, and after harvesting it for seed cuts the stalk into sections of one eye each, and each section when planted in the ground produces a new plant. This is know as "asexual" reproduction and all further propagation from the original seedlings breeds completely true.

The cuttings are planted in a line or a row giving rise to the description "line test". On maturity the cane is subjected to more intensive tests. It is run through a small cane mill to extract the juice, which is then subjected to chemical analysis through Brix tests and polariscopic readings. Varieties which show promise under the line tests are further propagated in "increase" plots, for the purpose of establishing sufficient quantities of seed cane for multiple plantings. Once the necessary seed is produced upon maturity in the "increase" plots, widespread plantings are made

in numerous locations to test adaptability and suitability to various soil and climatic conditions. Each stage of planting (usually two to three times during the season when the cane is reaching maturity) is subjected to the same study and chemical analysis by the agronomist. Other physiological phenomena are studied such as disease resistance, maturity hardness, milling qualities, ratooning, stubbing and resistance to wind and cold. As these studies progress hundreds of the plants fall by the wayside. Out of one million crosses by the Canal Point Station there are only twenty new varieties that have been produced worthy of consideration (R. Stevens 240-241, 246-250; Bourne 105-107).

The agronomic studies to evaluate and select a new variety are indispensable. Without them no breeder or any cane man or men for that matter can tell the value of the new seedlings. To find a good new variety is a laborious process of trial and error (R. Brandes 201; Allison 225).

Petitioner made his first crosses for the Experiment Station in 1930 in a field at Lake Harbor, sometimes referred to as Miami Locks. This field was owned by Southern Sugar Company but had been furnished to the experiment station for its work. The plants produced by these crosses were know as the 30 seedlings. Subsequently one of them proved to be a good variety and was known as F30-35 now covered by Plant Patent 210 (R. Bourne 137). A year lated the 31 seedlings were bred. From them sprang F31-436 and F31-962, Plant Patents No. 220 and No. 203, respectively. On these series of crosses Petitioner bred

them and Stevens did the agronomic work from which the selection of these varieties was made (R. Bourne 99, 128, 132-150; Allison 224-225; Stevens 250, 252-253; R. DX34; DX14; DX16; DX30; DX31).

The crosses made by the Petitioner were for and on behalf of the Everglades Experiment Station, a substation of the University of Florida, and were made during and in the course of his employment. Stevens likewise performed his selective work as such employee (R. Stevens 251; Allison 224-225; R. DX-13-24, 28, 72-75, 77, 78; R. Bourne 120).

The Petitioner compiled and caused to be published a "bulletin" for dissemination by the Belle Glade Station, a copy of which he sent to "Facts about Sugar". This is a publication of a trade journal of general circulation through the cane world. The article discusses all the crosses made in 1903 and 1931 by the author. It lists the seedlings produced, including those under study. The three varieties in question were included among them. In addition to this there were other publications emanating from Bourne disclosing the new varieties under consideration. He filed notes and reports from time to time. Some of these went out in bulletin form. Annually he filed progress reports. Everything on record with the Station became public property accessible to any and all cane men who were interested. His annual reports were summarized in the State Experiment Station Annual Year Book and put in circulation (R. Bourne 111-113, 114, 201-202; Allison 227; R. DX2, 9, 29).

Species of sugar cane bear names but all new varieties bred are identified by a symbol number. The

letter "F" designates Florida for the Everglades Experiment Station where it was bred. In the symbol "F30-35", 30 designates the year in which the cross was made; the second number 35 refers to the number of seedlings of the cross. Every station has a similar symbol designation of varieties (R. Bourne 94-95; R. Stevens 252; R. Brandes 203; R. Fourmey 234).

The varieties of cane disclosed by the publications could be easily reproduced by any person by referring to the records of the Everglades Station, locating the cane in the field, cutting an eye from the stalk, planting it the ground and letting is grow. Because of this, meticulous care was exercised to accurately identify the variety of every cane plant at the field. Each seedling is tagged with its variety number. Detailed field maps were kept to identify and segregate the varieties (R. Brandes 203-204; R. Bourne 113; R. DX40-45; DX53-55; DX46, 49, 60, 63, 65, 67, 79-82).

As the new varieties from the crosses began to show promise and there was enough seed available for distribution, it was made available to cane growers. The Everglades' producers were in desperate need of good varieties free from disease. The growers could not await the usual routine of complete agronomic selection which would have delayed them a number of years (R. 243-244, 225-226). Stevens made distribution to the growers, the cane becoming their property for commercial use without strings with Stevens merely retaining the right of ingress and egress to observe the growth and take sample stalks for testing (R. Stevens 241). U. S. Sugar Corporation was the principal recipient of seed distribution. Its fields at Azucar, now Bryant, near Canal Point, were used by Everglades

Experiment Station for its heaviest increased plantings. All of U. S. Sugar Corporation's vast acreage of the patented varieties has its origin from original Experiment Station's seed cane. Among other Glades' growers who share in the distribution were Brown & Company, sometimes referred to as Shawano, and later known as Hillsboro Plantation; also Dixie Land & Cattle Company, H. S. Johnson, Arnold Brothers, Parker Bryant, Felsmere Sugar Company and numerous Florida cane growers. Before this distribution, test planting by Stevens was made at the Florida Experiment Station at Lake Alfred, Quincey and elsewhere (R. Stevens 243-245, 247, 252, 258, 270; R. Beckett 235; R. Heiser 182-184; R. Fourmey 323-341; R. Bryant 221-222; R. DX61, 62, 65, 66, 68, 69; DX63, 79-82).

Bourne then severed his connection with the Everglades Experiment Station and went to work for U. S. Sugar Corporation as Director of its Research Department (R. 90; DX25; DX26). No one at the Experiment Station or any of the growers or users of the cane derivatives were aware that Bourne had obtained a plant patent (R. 228; R. DX6; DX27). Upon changing jobs, Bourne, upon advice of his patent counsel, voluntarily recognized shop rights in the Experiment Station and the U. S. Sugar Corporation (R. Bourne 130-131; 150-151; DX27; DX70; DX32).

To promote the growth of cane, the U. S. Sugar Corporation organized a group of independent growers out of which the U. S. Sugar Corporation collected benefits in excess of one million dollars. The sugar company financed the grower, furnished him with seed cane, technical advice and such labor, equip-

ment and fertilizer as he might need to plant crops. The grower, in turn, by contract, sold his cane to a Clewiston mill owned by the Company. During the first two years the independent growers were limited to three in number, to-wit: Mr. Cowin, P. G. Bishop and Otto Larsen. *Bourne was designated* by the company to select the varieties and to furnish the seed cane, and is so doing he recommended the three varieties on which he claimed patent rights. In 1936 additional residents were brought into the organization (R. Redelsheimer 315-322; Larsen 305-314; Jones 170-182; Bishop 341-344; R. DX36).

The Petitioner never informed any of the growers of his patent or personal rights in the cane. Their plantings were open and notorious, available to the public and close to the Sugar Corporation cane fields. Bourne knew all about the alleged infringements all through the years before suits were filed (R. 341-344; R. Jones 176; R. Larson 307; R. Bourne 150-152).

Notices of infringement were sent out by Bourne's attorney on June 19, 1942 (R. 4).

Dr. Brandes, the instigator of the breeding procedure in Florida, testified that Petitioner performed no inventive ingenuity in making the crosses, and Stevens claimed that by his agronomic testing and selection he discovered the canes (R. Bourne 214-215; R. Stevens 289).

ARGUMENT

Summary

Rule 8(b) of the Federal Rules of Civil Procedure superseded the methods of pleading prescribed in 35 U.S.C. § 69 (1946) and there are no decisions of other circuits holding to the contrary on which to predicate this petition for certiorari.

The District Court found, and the record supports the findings, that Petitioner alone did not determine the characteristics of the patented varieties of sugar cane, but that one F. D. Stevens was a joint inventor. The evidence shows and the Court found that the Petitioner did the breeding work and Stevens did the agronomic work, which were inter-related, dependent parts of the joint project, making them co-inventors.

The evidence shows and the Court found that the only accurate way used by cane experts to identify the characteristics of sugar cane varieties is by the symbol number given each plant, which traces its geneology; not by its morphological characteristics. Experts rely on the records for identification, and Stevens and other users kept voluminous records, cards and maps contemporaneously with and showing the public use of the varieties by symbol numbers.

ASSIGNED ERRORS 1 AND 2

1. "The Courts below erred as a matter of law in holding United States Code, Title 35, Section 69

(R. S. 4920) was superseded by the Rules of Civil Procedure for District Courts."

2. "The Courts below erred as a matter of law in holding Plant Patents Numbers 203, 210 and 220 invalid on the grounds of prior public use and patentee not sole and first inventor, in the absence of 30 day notice required by United States Code Title 35, Section 69 (R. S. 4920), and over objection of plaintiff."

Neither the final decree of the Lower Court (R. 21-34), the order denying the motion for rehearing (R. 62), nor the decision of the Court of Appeals for the Fifth Judicial Circuit, made any reference to 35 U.S.C. § 69 (1946) or to the Federal Rules of Civil Procedure. The question arises only by virtue of a ruling by the Lower Court, during the progress of the trial, that Rule 8(b) of the Federal Rules of Civil Procedure superseded the statutory requirement of 35 U.S.C. § 69 (1946), (R. 63).

A careful examination of the printed reports of the decisions cited by Petitioner fails to disclose whether the effect of Rule 8(b), Federal Rules of Civil Procedure, was raised or considered. Certainly there is no statement in any of the cases reported that Rule 8(b) did not supersede 35 U.S.C. § 69 (1946).

What the decisions of other circuits might have been, had the issue been raised, is purely guesswork.

That the Advisory Committee on Rules so intended is clear from the note to Rule 8, Title 28,

U.S.C.A., at page 254, in which it was said:

> "This rule supersedes the method of pleading prescribed in U.S.C.A., Title 35 * * *, Section 69 (pleading and proofs of action)."

As to conflicts between the rules and statutes, it has been held:

> "Where a rule of civil procedure conflicts with a former statute, the rule prevails." *Penfield Co. of Cal.* v. *Securities and Exchange Commission,* 330 U.S. 585, 67 S. Ct. 918, 91 L.Ed. 615, (Cal. 1947).

That the textbook writers on federal practice so interpret the effect of Rule 8(b) cannot be questioned. 1 Moore, *Federal Practice,* 73, 565; 17 Hughes, *Federal Practice, Jurisdiction and Procedure,* § 19683.

ASSIGNED ERROR 3

3. "The Courts below erred as a matter of law in holding that there was a joint invention of plant patents numbers 203, 210 and 200."

This assigned error completely disregards the entire weight of the evidence and the findings of fact by the District Court which were approved by the Court of Appeals.

> "Finding of trial court in patent cases based upon conflicting testimony, lay or expert, must be sustained unless clearly erroneous. Federal Rules of

Civil Procedure, Rule 52(a), 28 U.S.C.A." *Pointer v. Six Wheel Corporation,* 177 F. 2d 153 (9th Cir. 1949).

The record establishes that Petitioner was employed by the Everglades Experiment Station as a breeder, and Stevens was employed as an agronomist (R. Allison 224-228; Bourne 93; DX10, 11, 12, 13, 14, 15, 16, 17, 18 and 19). It takes the combination of both the breeder and the agronomist to determine and select the characteristics, and the crossing, development and selection of the specific canes was the joint work of both Bourne and Stevens (R. Brandes 201; Allison 224-227). Stevens made what is known as a line test, and from the tests made by both men the characteristics of a sugar cane variety could be accurately determined. It was from these tests that selection of the patented varieties was made (R. Allison 225).

Based on this testimony, the decision of the Court of Appeals for the Fifth Circuit is not in conflict with any decision of any other corcuit court, and the finding that Petitioner and Stevens were joint inventors is amply sustained by the facts and the law.

ASSIGNED ERROR 4

4. "The Courts below erred as a matter of law in holding that there was prior public use within the meaning of the patent Statutes of the subject matter covered by Plant Patents numbers 203, 210 and 220."

Sugar cane is perishable. The crops are cut and

replanted and it is obviously impractical and unrealistic to suppose that stalks of cane will be preserved for the purpose of evidentiary use in future patent litigation where no one contemplates a patent will be obtained.

Irrespective of that, however, the experts testified in this case that the method used for identification is by symbol numbers (R. Bourne 94-95; Stevens 252; Brandes 203-207; Fourmey 234), which is more accurate than morphological characteristics as any number of varieties could enjoy or possess the same type of cell structure.

The testimony showed that meticulous care was exercised to tag every seedling with its symbol number. Detailed field maps were kept to identify and segregate the varieties. Because of the emergency existing, the growers could not wait for the usual routine of agronomic selection, and as the promising varieties were discovered, unequivocal distribution was made to various commercial users (R. Brandes 203-204; Bourne 113; DX40-45; DX53-55; DX46, 49, 60, 63, 65, 67, 79-82; R. 225-226, 241, 243-244).

Not only were the records of Stevens produced which showed contemporaneous public use, but numerous commercial users testified (R. 243-245, 247, 252, 258, 270; Beckett 235; Heiser 182-184; Fourmey 323-341; Bryant 221-222; DX61, 62, 63, 65, 66, 68, 69, 79-82).

From the records of the Experiment Station and the records, maps and cards of planting reflecting symbol numbers, an accurate description of prior use was produced and the lower courts so held.

This decision is not, therefore, in conflict with *Mast, Foos & Co.* v. *Dempter Mill Mfg. Co.*, 82 Fed. 327 (8th Cir. 1897), which had only the unsupported oral testimony of one witness to show public use.

Nor does *Peerless Roll Leaf Co.* v. *H. Griffin & Sons, Co.*, 29 F.2d 646 (2nd Cir. 1928) conflict, since the cane varieties were turned over to numerous growers for commercial planting and the public was not excluded.

Emerson & Norris Co. v. *Simpson Bros. Corp.* 202 Fed. 747 (1st Cir. 1913), and *Brooks* v. *Sacks*, 81 Fed. 403 (1st Cir. 1897), are not in conflict since the oral testimony was supported by complete, meticulous written records, maps and cards made contemporaneously with the public use.

CONCLUSION

Respondent respectfully submits that the decision of the Court of Appeals for the Fifth Circuit is not in conflict with decisions of other circuits and the certiorari should be denied. No argument was made on ground 3 on the basis of jurisdiction. In fact, no argument could be made because it is common knowledge that in Puerto Rico in the First Circuit and Hawaii in the Ninth Circuit raising of sugar cane for sugar production constitutes the major industry. Therefore, the cane patents do not dominate an industry concentrated in the Fifth Circuit.

Respectfully submitted,

R. Bruce Jones, of
Earnest, Lewis, Smith and Jones
Attorney for Respondent
West Palm Beach, Florida

October 30, 1953